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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,807	08/04/2003	Kar-Wing Edward Lor	58268.00238	4599

32294 7590 02/15/2008
SQUIRE, SANDERS & DEMPSEY L.L.P.
14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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02/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

AK

Office Action Summary

Application No.

10/632,807

Applicant(s)

LOR ET AL.

Examiner

APRIL Y. SHAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21--60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20080213</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicant's after final amendment, filed 28 November 2008, has been received and entered into the record, and respectfully and carefully considered.

Election/Restrictions

2. Applicant's election of Species I (Claims 1-40) in the reply filed on 7 September, 2007 is acknowledged. However, after careful consideration and discussion with the Applicant's representative (See interview summary), the examiner withdraws the Election/Restriction requirement. Therefore, claims 1-60 have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 21-40 and 51-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claims 21-40 and 51-60 are directed to a network device for controlling a flow of data in a wireless network. However, on page 50, paragraph [0156] of the instant application's specification, the Applicant discloses "The present invention can be implemented **totally...through software.**" Therefore, it appears that the network device would reasonably be interpreted by one of ordinary skill in the art as software,

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per se. There is no element positively recited as part of the network device. As such, it believed that the apparatus of claims 21-40 and 51-60 are reasonably interpreted as functional descriptive material, per se.

Double Patenting

6. Claims 41-60 are objected/rejected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-40. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

7. Applicant's argument filed 28 January 2008 for claims 1-20 have been fully considered and they are persuasive (See allowable subject matter below)

8. The Applicant argues on pages 22-26 that "...Applicant respectfully request that the rejection of claims 21-40...under 35 U.S.C 101 be withdrawn and submit that claims 21-40 are now in condition for allowance", the examiner respectfully disagree and maintained the rejection.

First, the examiner's position that in the original disclosure, it discloses "The present invention can be implemented **totally...through software.**" Therefore, it appears that the network device would reasonably be interpreted by one of ordinary skill in the art as software, per se. There is no element positively recited as part of the network device.

Second, the Applicant argues that the examiner must give claims their broadest reasonable interpretation **in light of the supporting disclosure.** During the examiner's examination to claims 21-40, the examiner indeed gave claims 21-40 their broadest reasonable interpretation in light of the supporting disclosure on page 50, paragraph [0156] of the instant application's specification, the Applicant discloses "The present invention can be implemented **totally...through software.**"

Third, the Applicant did not provide explicit definitions of the elements recited in claims 21-40 in the original disclosure. Therefore, the original disclosure does not contain any statement instructing one to interpret these elements are **always** referring to hardware, or a combination of hardware and software rather than **totally...through software (software per se).** Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." Multifactor

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Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.”

Fourth, the examiner suggests amending the claim to recite a hardware element in the body of the claim in order to make the claims statutory. Any amendment should be commensurate with its corresponding disclosure.

Allowable Subject Matter

9. Claims 1-20 are allowed.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


13 February, 2008
AYS



THANHNGA TRUONG
PRIMARY EXAMINER